

REMARKS

Claims 1 – 211 are pending. Of these claims 1, 64, 159, 182 and 197 are independent.

The restriction requirement for claims 191 – 193, 196, 198 – 199, 203, 207 – 208 and 211 is traversed for the reasons set forth below. The Examiner has not applied the correct standard to the claims in question.

The rejection of independent claims 1, 64, 159, 182 and 197 under § 103 based on (De Lapa – US Patent No. 5,822,735) is also addressed by argument and traverse as described below. The prior arguments of record are also incorporated by reference herein.¹

The rejection of the dependent claims is also traversed. Applicant repeats his request for a more complete and substantive response on many of the claims which have been rejected without any meaningful explanation. In many instances it appears the Examiner has completely ignored limitations in the claims; yet it is not possible to glean what she is relying upon in the reference to reject the claim. This is inappropriate and prevents any effective resolution on the merits, because Applicant is forced to speculate and guess on the Examiner's interpretation and analysis. These omissions make it difficult - if not impossible – to respond meaningfully to the Office Action. In this regard Applicant believes he is not being given a fair or adequate opportunity to address the substance of the rejections since they are not adequately expressed. Without an exposition of the arguments on the record it will not be possible to put this case in condition for an appeals board or other authority to review effectively.

¹ See e.g., REQUEST FOR RECONSIDERATION/PETITION TO WITHDRAW THE FINALITY OF THE OFFICE ACTION filed in the instant case on September 6, 2005; and ARGUMENTS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW filed November 3, 2005.

TRAVERSE TO RESTRICTION REQUIREMENT

The Examiner has unilaterally withdrawn claims 191 – 193, 196, 198 – 199, 203, 207 – 208 and 211 from consideration, on that basis that they are a non-elected invention. The Examiner cites 37 C.F.R. 1.142(b) and MPEP 821.03.

The MPEP indicates that the appropriate standard for subsequent presentation of claims is controlled by 37 C.F.R. 1.145:

...If, after an office action on an application, the applicant presents claims directed to an invention ***distinct from and independent of*** the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed... (emphasis added)

The claims noted by the Examiner are all dependent claims. These dependent claims all depend from claims which the Examiner has now examined. As a matter of law these dependent claims cannot be “independent” of their respective base independent claims. Moreover 37 C.F.R. 1.142 (b) recites effectively the same language “...If two or more ***independent and distinct*** inventions are claimed in a single application...” the Examiner can request an election.

Consequently Applicant traverses the rejection since the new claims, as submitted, merely depend from claims which the Examiner has otherwise accepted as properly within the invention as originally claimed. They cannot be “independent” within the meaning of this part of the regulations.

TRAVERSE AND ARGUMENT TO PRIOR ART REJECTIONS

The Examiner has again relied solely on the De Lapa reference to reject claims 1 – 159, 164 – 166, 168 – 170, 179, 180, 182, 185 – 187, 189 – 190, 194 – 195, 200 – 202, 206, 209 – 210 under 35 USC 103. This rejection is traversed for the following reasons.

Independent Claims 1, 64, 159, 182 and 197

In response to the Examiner’s comments, Applicant offers the following:²

Paragraph 4, page 6: First, the Examiner argues (in paragraph 4, page 6) that De Lapa shows that “..the same coupon type can be offered to various members who are eligible for

² Again no waiver, limitation or estoppel should be taken from the comments of the present response which are strictly directed to the language of the claims in the present application.

the offer.” Again, with all due respect, the Examiner is not parsing the limitation of the claim quite correctly; the claim states:

...wherein said financial product/service set includes at least one or more financial products or financial services that is at least considered for offering **to each entity** in said entity set who is being considered for an offer.

This limitation specifically recites that each entity can be considered for offering the financial product/service. The Examiner does not dispute that that once De Lapa exhausts a particular coupon, that coupon cannot be considered for an offering for any other members. By definition, once the particular coupon is gone, no further consideration can be given to offering it to another member.

As noted in the prior response, incorporated by reference herein, De Lapa works in an opposite manner to the present invention, and teaches away. He starts off with a member list, and then tries to find appropriate coupons from a remaining limited subset of the original coupons.

“...the cyclic coupon selection mailing routine selects coupons by consumer, rather than vice versa” See, e.g., col. 15, ll. 46+ (emphasis added).

The Examiner’s comment that the coupon “can be sent” to various members misses the point, because while it can be sent to a subgroup of the members, it cannot be considered for an offering for each of the members. De Lapa clearly cannot meet this limitation.

As explained before, one useful distinction of the present invention is that if there is an appropriate financial product for a particular entity, then it should be at least considered for offering to such entity (as well as any other entities). This should occur whether the entity is the first or the last in the entity set, i.e., without regard to the order in which the entity is processed. De Lapa cannot do this.

Paragraph 5, page 6: With respect to the Examiner’s second point, again, the argument is not applicable because the Examiner acknowledges that the variability in offers in De Lapa are for two different coupons, not for a single coupon:

“...in De Lapa a single type of dog food coupon, can be offered to different customers...” See Office Action paragraph 5, page 6.

Again, however this is beside the point; the fact remains that no single individual coupon in De Lapa is varied; the Examiner has not rebutted the fact that De Lapa

specifically notes that the variation in coupon discounts is only done for two different coupons:

Coupons are currently being encoded with bar codes, such as UPC codes, which are provided for the purpose of identifying the manufacturer and brand of the product being discounted, the family of goods to which the product belongs **and the value of the discount...**” See e.g. De Lapa at col. 2, ll. 6 – 10. (emphasis added)

Again De Lapa only discloses the use of identical content for selling a particular coupon; the present invention allows for the possibility of a partially customized identification, specification and/or promotion of a financial product/service, which is a significant benefit in mass marketing applications – particularly those involving sophisticated products/services.

Paragraph 6, page 6:

The Examiner states that if there is no match for a particular optional coupon, that coupon is not sent to the customer in De Lapa. Again, however, this is beside the point, because De Lapa merely fills that spot with yet another coupon, and still sends an entire coupon sheet to that customer. Thus, De Lapa always offers something to a customer, whether the final selection is appropriate or not. In contrast in the invention of claim 1 it may be determined not to send anything to a particular entity.

As De Lapa works exactly opposite to the logic of this claim, Applicant again submits that this is yet further conclusive proof of non-obviousness.

Paragraph 7, page 6:

Again, the Examiner’s response is conclusory, and argues that it is never possible to have a patentable difference for a process based on differences in products handled by such processes. The Applicant was the first to consider implementing certain automated techniques within the field of financial products/services. These products/services have their own particular requirements and idiosyncrasies, which make them quite different from the simple coupons set out in De Lapa. Thus it is not surprising that De Lapa makes no mention of such products for inclusion in his system. The Examiner has not provided any evidence to date from a credible prior art source that suggests that coupons and financial products/services could be treated the same at the time of the filing of the invention. Barring such conclusive evidence, a taking of official notice (as suggested on page 4) is

inappropriate and is traversed. Moreover the Examiner has still not demonstrated how/why it would have been obvious - even if such financial products/services were well-known – to modify De Lapa to incorporate the same.

Furthermore, the Examiner did not apparently even consider the following limitation in independent claim 182, which further defines over De Lapa:

wherein said financial product/service set can include at least one financial product or financial service that is predetermined as being suitable for a variable information offer to each entity in said entity set.

De Lapa does not show any kind of differentiation in treatment for his coupons to see if some are more suitable for a variable information offer. Absent any evidence from the Examiner on these limitations the undersigned submits that the claim should be allowed.

Similarly in claim 197 the Office Action does not address the above corresponding limitation.

According Applicant submits that claims 1, 64, 159, 182 and 197 clearly distinguish over De Lapa for several reasons set forth above. Reconsideration and allowance are earnestly requested.

DEPENDENT CLAIMS

Claims 2 – 11

To wit, the Examiner rejected claims 2 – 11 by repeating the identical rejection as before (see page 4, bottom paragraph). With the exception of claim 9, none of the limitations pointed out by the Applicant for claims 5 – 10 as set forth in the prior Amendment and Response are addressed in any fashion in the Office Action. Hence this rejection is traversed. For claim 9 the Examiner states (paragraph 8, page 7): “..in De Lapa the information is updated via a processor in real time...” Notably the Examiner cites no part of De Lapa as support for this proposition, and doesn’t explain what “information” she is referring to. If the Examiner believes De Lapa shows such limitations of claim 9: “...automatically modifying on a real-time basis said variable information so as to be more desirable to said entity” she is kindly requested to point out what part of De Lapa she is relying upon.

Again, if the Examiner believes there is something in the prior art pertaining to these other limitations in the other dependent claims she is respectfully requested to point it out

more particularly so the merits of the rejection can be discussed and responded to meaningfully. As the MPEP states:

It is important for an examiner *to properly communicate the basis for a rejection* so that the issues can be identified early *and the applicant can be given fair opportunity to reply*. MPEP 706.02(j) (emphasis added)

The reason for this is to avoid piecemeal examination, which is also discouraged by the MPEP:

Piecemeal examination should be avoided as much as possible.Where a major technical rejection is proper, *it should be stated with a full development of reasons* rather than by a mere conclusion coupled with some stereotyped expression. MPEP 707.07(g) (emphasis added)

In the meantime, since the Office Action contains no specific hint of where such limitations are disclosed or suggested in De Lapa, Applicant submits that the present §103 rejections for such claims cannot be sustained in the face of a complete lack of evidence. One of the key criteria needed to establish *prima facie* obviousness of a claimed invention is that all the claim limitations must be taught or suggested by the prior art. In *re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In *re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). *See, e.g.*, MPEP 2143.03; 706.02(j).

This has clearly not been done for claims 2 – 11 and thus the rejection should be withdrawn.

Claims 12 – 52

These claims are allowable for at least the reasons set forth above for claim 1 and the other independent claims. Moreover, despite the fact that claims 12 – 52 set out an additional 40 separate inventions and limitations, the Examiner merely repeated the earlier rejection, but now adds that she is relying on “official notice” that is well-known in the art to select different mediums in which to deliver information to users. See Page 5 of the Office Action.

Applicant does not dispute that email and regular mail were known in the art; however, selecting a particular delivery medium for presenting offers on financial products/services was not known in the art. Moreover this rejection oversimplifies the many other limitations presented in claims 12 – 52, 74 – 115, 132 – 138, 142 and 170, most of which the Examiner has still not even addressed. To wit, the Examiner still has presented

no evidence of what she is relying on to reject the additional limitations in claims 24, 25, 26, 28, 29, 31, 32, 34, 35, 37, 38, 43, 45, 46, 47, 48, 50, 51, 52.

Nor did the Examiner respond to any of the analyses set forth in the prior Amendment that nothing in De Lapa discusses a “plurality of delivery mediums.” Instead the Examiner takes “official notice” of such fact, again without any supporting evidence, but just based on her uncorroborated opinion. See pages 5 and paragraph 9, page 7. Nowhere does the Examiner address the limitations of claim 31 – “selectively placing at least some content in blank spaces...” or a “reply means” (claims 45 - 50) etc., etc.

Again should the Examiner believe there is something there, she is respectfully requested to point it out more particularly so the merits of the rejection can be discussed and responded to meaningfully and as required by MPEP 706.02(j) and 707.07(g) to avoid further piecemeal examination.³

Since there is no substantive citation in the current record pertaining to the above limitations, Applicant submits that the present §103 rejections for such claims cannot be sustained. For this reason the rejections should be withdrawn.

Dependent claims 74 – 115; 132 – 138, 142, 170 and 180

See discussion for claims 12 – 52.

Dependent claims 53 - 58

These claims were again rejected based on the same basis as for claim 1. In the prior response, Applicant pointed out several additional areas where these claims distinguish over De Lapa. However the recent Office Action merely repeats the prior rejection, and contains absolutely no discussion to counter the points made by the Applicant.

³ The Examiner’s request, in paragraphs 10 - 11, is also traversed. With respect to paragraph 10: Applicant has pointed out that the dependent claims do not stand or fall with the base independent claims. To establish prima facie obviousness of a claimed invention – including a dependent claim - **all** the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If the Examiner insists on applying 103 rejections to the dependent claims, she should understand that she needs to do so within the requirements of the case law, which requires an examination of all the limitations of the claim, and an indication of where they are taught or suggested in the prior art to adequately support such rejection. With respect to paragraph 11: the Applicant filed these claims almost 5 years ago and the original claim almost 7 years ago; there has been ample opportunity for the PTO to review the merits of the same, and to raise any objections as to the number of claims. Moreover as the Examiner acknowledges, there is substantial overlap and duplication in the claims which should make it rather easy to review their substance. *See e.g.*, claims 26, 89, 76, 191 and 206, all of which pertain to using a plurality of delivery mediums.

Again the Examiner is respectfully requested to point out more particularly any part of De Lapa she is relying upon so the merits of the rejection can be discussed and responded to meaningfully and as required by MPEP 706.02(j) and 707.07(g) to avoid further piecemeal examination. As there is no substantive citation in the current record pertaining to the above limitations, Applicant submits that the present §103 rejections for such claims cannot be sustained. For this reason the rejections should be withdrawn.

Dependent claims 59 – 63; 122 – 126; 139 – 140; 205 - 206

These claims were rejected based on “official notice.” This is again traversed; the Applicant does not dispute that these claims are directed to more specific financial service/product embodiments. Nonetheless neither De Lapa nor any other reference cited by the Examiner provides any teaching, suggestion or hint to incorporate financial products/services into the kind of process set out in these claims.

Moreover this rejection oversimplifies the many other limitations presented in the claims most of which the Examiner has still not even addressed. Where in De Lapa is it shown “...using data related to at least said mortgage loan to at least one of select, design, and price said mortgage loan-related financial product or financial service”? Ditto for the other limitations in these claims.

Dependent claims 65 – 73; 116 – 121; 127 – 131; 141; 143 - 158

These should be allowable as well based on the discussion above for dependent claims 2 – 63 and 122 – 126; 139 – 140 and 205 - 206.

Dependent claims 160 – 179; 181; 183 – 196; 198 – 205; 207 – 211

Claims 160 – 163 depend from claims 1 and 64 and should be allowable for the reasons set forth above. Such claims further distinguish on the basis that they pertain to methods of ensuring that communication offers comply with various applicable compliance standards, regulations, etc. De Lapa's coupons do not include such information. Support for such claims can be found in the specification at among other places, page 27, ll. 18+ .

Claims 164 – 179 and 181 depend from claim 159 and should be allowable for the reasons set forth above. Such claims are substantially identical to counterparts already

submitted for claims 1 and 64.

Claims 183 – 196 and 198 – 205; 207 - 211 also mirror previously submitted dependent claims and should be allowable for the reasons set forth above.

CONCLUSION

For the reasons set forth above, Applicant requests reconsideration of the present rejection and allowance of the application. A petition and fee for a two month extension of time is also enclosed. Please charge such fees and any other fees due for the additional new claims to deposit account no. 501 – 244.

Respectfully submitted,

A handwritten signature in cursive script, reading "J. Nicholas Gross".

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